

REMARKS

Claims 1-15 were examined. Claims 1-8 were rejected, and Claims 9-15 were determined to be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. In response to the above-identified Office Action, Applicant declines to amend any claims, and presents the following arguments in support of the original, rejected Claims.

I. Claims Rejected Under 35 U.S.C. § 102(b)

The Examiner rejected Claim 1 under 35 U.S.C. § 102(b) as anticipated by U.S. Patent No. 4,920,553 issued to Sasaki *et al.* ("*Sasaki*"). For a claim to be anticipated under that statute, the reference must disclose every limitation of the claim. Applicant disagrees that *Sasaki* discloses every limitation of Claim 1.

Claim 1 recites an apparatus comprising a media receptacle to hold a plurality of media objects; a clip to engage and hold a media object; a suction device mounted to a side of the media receptacle to engage a first media object within the receptacle and move it to be engaged by the clip; and a switch coupled to the clip to cause the suction device to disengage the first media object. Applicant agrees that *Sasaki* discloses a media receptacle (a film supply magazine) but beyond that similarity, a number of differences exist.

First, *Sasaki*'s movable suction means **24** is not mounted to a side of the media receptacle, as Claim 1 requires. Instead, *Sasaki*'s suction means is mounted to a drive mechanism, which is itself mounted to the frame of the entire apparatus. *See Sasaki* figures 4A and 4B, and column 3, line 27 through column 4, line 24. Furthermore, *Sasaki* indicates that the media receptacles can be removed from the apparatus. *See* column 2, lines 29-34. There is nothing to suggest that the suction means would also be removed with the receptacle, as one would expect if the means was mounted to a side of the receptacle. Also, because the media receptacles are removable, there is not even a fixed spatial relationship between *Sasaki*'s media receptacle and suction means. Clearly, the suction means cannot be said to be "mounted to a side of the media receptacle."

Second, the selector switch identified by the Examiner at *Sasaki* column 5, lines 60-68, is not analogous to a switch coupled to the clip to cause the suction device to disengage the first media object. Instead, the selector switch determines from which film supply magazine (media receptacle) the suction means attracts unexposed film.

Selection of a supply magazine is not the same as causing the suction device to disengage a media object previously engaged.

For at least these reasons, Applicant submits that *Sasaki* fails to teach every element of Claim 1, and therefore the rejection of the Claim is improper. The Examiner is respectfully requested to withdraw the rejection.

As to Claim 8, the Examiner rejected Claim 8 under 35 U.S.C. § 102(b) as anticipated by *Sasaki*, merely by asserting that Claim 1 is representative of Claim 8. Applicant disagrees that Claim 8 must stand or fall with Claim 1, but in any case, at least two elements of Claim 8 are not taught by *Sasaki*, and so the rejection is not proper.

First, Claim 8 requires a clip coupled to a receptacle to engage and hold a media object from the receptacle during a digitization process. *Sasaki* teaches a multi-cassette X-ray film feeder system wherein the unexposed film is held by a holder while an X-ray is taken. Taking an X-ray and digitizing a media object are related in the way that taking a picture and viewing a picture are related, but they are clearly not the same thing.

Second, Claim 8 requires a suction assembly coupled to the receptacle to move the media object from the receptacle to engagement with the clip. *Sasaki*'s suction means only moves the unexposed film from one of the magazines to feed rollers 27a and 27b. It is these feed rollers that actually move the film into the holder even if we assume only for the sake of argument that the holder of *Sasaki* is analogous to the claimed clip.

For at least these reasons, Applicant submits that *Sasaki* fails to teach every element of Claim 8, and therefore the rejection of the Claim is improper. The Examiner is respectfully requested to withdraw the rejection.

II. Claims Rejected Under 35 U.S.C. § 103(a)

The Examiner rejected Claims 2-7 under 35 U.S.C. § 103(a) as unpatentable over *Sasaki* (*supra*) in view of U.S. Patent No. 4,280,691 issued to Blum ("*Blum*"), U.S. Patent No. 6,077,568 issued to Fort *et al.* ("*Ford*"), U.S. Patent No. 3,868,699 issued to Gardner *et al.* ("*Gardner*") and/or Japanese Patent Application No. JP 09-240858 by Daisuke *et al.* ("*Daisuke*"). Claims 2-7 depend directly or indirectly upon Claim 1, which was discussed and shown to be patentable over *Sasaki* in the previous paragraphs. For at least the reasons mentioned above, Applicant respectfully submits that Claims 2-7 are

also patentable over the prior art made of record, and requests that the rejections of these Claims be withdrawn.

III. Allowable Subject Matter

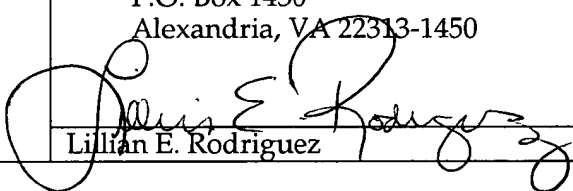
Applicants note with appreciation the Examiner's indication that claims 9-15 contain allowable subject matter.

CONCLUSION

In view of the foregoing, it is believed that all claims now pending, namely Claims 1-15, patentably define the subject invention over the prior art of record, and are in condition for allowance and such action is earnestly solicited at the earliest possible date. If the Examiner believes that a telephone conference would be useful in moving the application forward to allowance, the Examiner is encouraged to contact the undersigned at (310) 207-3800.

Dated: 10/5, 2004 Respectfully submitted,
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| <p>12400 Wilshire Boulevard Seventh Floor Los Angeles, California 90025 (310) 207-3800</p> | <p style="text-align: center;"><u>CERTIFICATE OF MAILING</u></p> <p>I hereby certify that the correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to:</p> <p style="text-align: center;">Mail Stop Amendment Commissioner for Patents P.O. Box 1450 Alexandria, VA 22313-1450</p> <p style="text-align: center;"> Lillian E. Rodriguez</p> <p style="text-align: right;">10-5-04 October 5, 2004</p> |
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